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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/490,362	01/24/2000	Steven M. Golden	2166	7063

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EXAMINER

ALVAREZ, RAQUEL

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 07/18/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/490,362

Applicant(s)

GOLDEN ET AL.

Examiner

Raquel Alvarez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 August 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-60 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20-60 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-19 have been canceled. Claims 20-60 are presented for examination.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 20-60 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 of U.S. Patent No. 5,761,648. Although the conflicting claims are not identical, they are not patentably distinct from each other because both are claiming common subject matter as follows: establishing electrical communication between a service system and a plurality of remote users; receiving profile data at the service system input by the remote users; transmitting redeemable coupons to the remote users.

3. Claims 20-60 are provisionally rejected under the judicially created doctrine of double patenting over claims 1-16 of copending Application No. 09/484,290. This is a

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provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: establishing a communication between a service system and a plurality of remote users; receiving profile data at the service system from the remote users; issuing offers for electronic certificates to the remote users, the electronic certificate offers being limited to selected remote users on the basis of the profile data; receiving at the service system inputs indicative of remote users selections; assigning identification data to each electronic certificate.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 36 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification lacks written description for the feature of "the coupon offers being transferred to a location designated by an issuer system". For purpose of examination, no patentable weight will be given to that feature.

Claim 37 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification lacks written description for the feature of "identifying the one or more users as having redeemed their coupons". For purpose of examination, no patentable weight will be given to that feature.

Claims 28-29, 38 and 43 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification lacks written description for the feature of "uniquely identifying each coupon and transaction data relating to a particular coupon". For purpose of examination, no patentable weight will be given to that feature.

Claim 59 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification lacks written description for the feature of "associating identification data with the redeemable coupons". For purpose of examination, no patentable weight will be given to that feature.

Claim 60 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification lacks written description for the feature of "associating identification data with the redeemable coupons after the entry of the profile data by the remote users". For purpose of examination, no patentable weight will be given to that feature.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 20-27, 30-35, 39-42, 44-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Von Kohorn (5,227,874 hereinafter Von Kohorn).

With respect to claims 20, 23-27, 32, 39-41, 49-51, 53-56 and 58 Von Kohorn teaches establishing a communication link between a plurality of remote users and a service system (i.e. the central station transmit broadcast product information to a response unit at a customer site)(Figures 1-5); receiving profile data at the service system from the remote users via the communication link, the service system then categorizing that profile data (see figures 28); issuing offers for electronic certificates to the remote users, the electronic certificate offers being limited to selected remote users on the basis of the profile data(see figure 28); prompting the remote users, in a manner designed to increase awareness of certain of selected remote users as to certain of the electronic certificate offers (figure 28); receiving at the service system inputs indicative of remote user selections of electronic certificate offers(Figure 28) and issuing selected electronic certificates in response to the selections of the electronic certificate offers(Figures 28 and 30).

With respect to receiving at the service system instructions derived from a plurality of issuer systems for issuing a predetermined type and number of the electronic certificates. Von Kohorn teaches a central station (service system) for presenting the coupons to the remote users, the coupons being for different products and sponsors. The sponsors of Von Kohorn like any other sponsors would likely determine the type and number of advertisements to be presented then it would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included receiving from the issuers or sponsors a predetermined type and number of electronic certificates because such a modification would allow the central station to know in

advance the types and numbers of the electronic certificates to be presented to the user.

With respect to using the Internet to establish an online communication and using e-mail to increase awareness. It is well known in the computer related arts to use the Internet to establish an online communication and the use of e-mail to obtain people's attention to information such as advertisements. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included using the Internet to establish an online communication and using e-mail to increase awareness because such a modification would broaden the use of the system to include a wider selection of remote users.

With respect to claims 21 and 52, the claims further providing reports based on the selection data and providing the report to the issuers. Since, Von Kohorn teaches analyzing the results of the user's selections and also Von Kohorn teaches a central station (service system) for presenting the coupons to the remote users, the coupons being for different products and sponsors. The sponsors of Von Kohorn like any other sponsors would likely determine the type and number of advertisements to be presented then it would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included sending an analyzes or report of the user's selections to the issuers or sponsors because such a modification would allow the issuers or sponsors to better target the users based on their selected responses.

Claim 22 further recites updating the profile data with usage data. Official notice is taken that it is old and well known to update profile data with usage data. For

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example, at Point of Sale systems (POS) the users of certain products are identified to enable retailers or advertisers to update the profile data for a particular household or individual. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included updating the profile data with usage data because such a modification would enable better characterization of the individual.

With respect to claims 30 and 31 additionally recite that the issuer system communicates directly with the service system using a shared computer network. Since, Von Kohorn teaches a central station (service system) for presenting the coupons to the remote users, the coupons being for different products and sponsors then it would have been obvious to include direct communication from the issuers (advertisers) to the central station(service system) to enable the central station to present the offers to the users.

Claims 33 and 35 further recite that the coupons selected are redeemed using a credit card. Official notice is taken that it is old and well known to identify the user of a coupon or a check by asking the user for an identification. For example, when a customer presents a check or a coupon the customer is asks to produce identification, this identification can be a credit card, a driver's license or the like. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included redeeming the coupons selected using a credit card for the above mentioned advantages.

With respect to claim 34, the claim further recites permitting the user to print the selected electronic certificates and redeeming the coupons by presenting them at the

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check-out. Von Kohorn teaches on Figure 34-A that the user can print the coupon by selecting from the response unit, the coupons can be redeemed in retail establishments.

Claim 42 further recite that the coupons are revised by the service system in an interactive and instantaneous basis. Since, the central system (service system) of Von Kohorn receives the coupons from the sponsors or the issuers and since Von Kohorn's system is computer implemented then it would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included revising the coupons received at the central system because such a modification would allow for instantaneous or interactive changes to be made if necessary.

Claims 44-46, 48 and 57 differ from claims 20, 49, 51, 55, 56 and 58 in that the claims further recite receiving demographic data at the service station from the user and the certificates being issued according to the demographic data received. Since, Von Kohorn teaches that the central station (service station) receives user's information such as user's interests, responses and selections based on that information, the awards or advertisements will be displayed to the users (see figure 28). It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included demographic data as part of the information received from the customer in order to better target the advertisements.

With respect to claim 47, the limitations were previously addressed in the rejection to claims 21 and 52 and therefore rejected under similar rationale.

Point of contact

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6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raquel Alvarez whose telephone number is (703)305-0456. The examiner can normally be reached on 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric w Stamber can be reached on (703)305-8469. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9326 for regular communications and (703)872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-1113.

Steve Gravini for us

R.A.
July 11, 2002

**STEPHEN GRAVINI
PRIMARY EXAMINER**